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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,680	01/15/2002	Thomas Joseph Pecorini	05015.0388U2	4839
22045	7590	05/24/2005	EXAMINER	
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			SHOSHO, CALLIE E	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 05/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/050,680

**Applicant(s)**

PECORINI ET AL.

**Examiner**

Callie E. Shosho

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-5,7,9-11,13-16 and 18-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-5,7,9-11,13-16 and 18-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/28/05</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

**Continued Examination Under 37 CFR 1.114**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/28/05 has been entered.

2. It is noted that claims 1, 3-5, 7, 9-11, 13-16, and 18-25 were previously allowed as set forth in the Notice of Allowability mailed 11/29/04. Subsequently, applicants filed RCE along with IDS on 2/28/05.

In light of the filing of a proper RCE on 2/28/05, prosecution of pending claims 1, 3-5, 7, 9-11, 13-16, and 18-25 was reopened and an action on these claims set forth below.

**Information Disclosure Statement**

3. It is noted that EP 277598 has been stricken from the IDS filed 2/28/05 as redundant given that the reference has already been cited on PTO-892 mailed with the office action of 3/22/04.

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-11, 13-16, and 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 54129050.

Using English translation of JP 54129050 provided by applicants, it is noted that JP 54129050 discloses coloring masterbatch, i.e. concentrate, for polyester wherein the masterbatch comprises pigment and 12-58% ethylene-ethyl acrylate copolymer. The copolymer contains 5-30% ethyl acrylate and 60-95% ethylene. There is no disclosure of low melt viscosity resin. There is also disclosed method of preparing polyester composition comprising adding the above masterbatch to polyester. The masterbatch is present in the polyester composition in amount of, for instance, 1.8% as calculated from application example 1. It is further disclosed that the polyester composition is used to make molded article (claims, page 4, 1<sup>st</sup> full paragraph – page 5, 3<sup>rd</sup> full paragraph, and application examples 1 and 2). Given that JP 54129050 discloses polyester composition identical to that presently claimed, i.e. prepared from identical color masterbatch, i.e. concentrate, and polyester, it is clear that the composition would inherently possess same inherent viscosity and moisture content as presently claimed.

In light of the above, it is clear that JP 54129050 anticipates the present claims.

6. Claims 1, 3, 10-11, 13, 16, 18-22, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 370424.

EP 370424 discloses masterbatch, i.e. concentrate, for polyester wherein the masterbatch comprises 5-70% carbon black and 5-90% modified polyolefin such as ethylene-methyl acrylate copolymer or ethylene-ethyl acrylate copolymer wherein the copolymers comprise 0.01-5% alkyl acrylate and 95-99.5% ethylene. There is also disclosed method of preparing polyester composition comprising adding the above masterbatch to polyester. It is further disclosed that the polyester composition is used to make molded article. While EP 370424 discloses the use of polyolefin wax, i.e. low melt viscosity resin, it is noted that the polyolefin wax is not required in the composition, i.e. present in amount of less than 70 wt.% (col.2, lines 29-31, 40-46, and 53-55, col.3, lines 9-10, 19-21, and 36-40, col.5, line 37, col.6, lines 20-25, and col.7, lines 47-56). Given that EP 370424 discloses polyester composition identical to that presently claimed, i.e. prepared from identical color masterbatch, i.e. concentrate, and polyester, it is clear that the composition would inherently possess same inherent viscosity and moisture content as presently claimed.

In light of the above, it is clear that EP 370424 anticipates the present claims.

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 3-5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54129050 in view of EP 370424.

Using English translation of JP 54129050 provided by applicants, it is noted that JP 54129050 discloses coloring masterbatch, i.e. concentrate, for polyester wherein the masterbatch comprises pigment and 12-58% ethylene-ethyl acrylate copolymer. The copolymer contains 5-30% ethyl acrylate and 60-95% ethylene. There is no disclosure of low melt viscosity resin.

There is also disclosed method of preparing polyester composition comprising adding the above masterbatch to polyester. The masterbatch is present in the polyester composition in amount of, for instance, 1.8% as calculated from example 1. It is further disclosed that the polyester composition is used to make molded article (claims, page 4, 1<sup>st</sup> full paragraph – page 5, 3<sup>rd</sup> full paragraph, and application examples 1 and 2).

The difference between JP 54129050 and the present claimed invention is the requirement in the claims of specific olefin/acrylate copolymer.

JP 54129050 discloses the use of ethylene-ethyl acrylate copolymer.

EP 370424, which is drawn to masterbatch for polyester as is JP 54129050, discloses the use of ethylene-methyl acrylate copolymer in order to produce polyester composition that has no light-shielding or appearance problems. Further, EP 370424 discloses the equivalence and interchangeability of ethylene-ethyl acrylate as disclosed by JP 54129050 and ethylene-methyl acrylate as presently claimed (col.2, lines 32-39 and col.3, lines 9-10).

Given that JP 54129050 in view of EP 370424 discloses polyester composition identical to that presently claimed, i.e. prepared from identical color masterbatch, i.e. concentrate, and polyester, it is clear that the composition would intrinsically possess same inherent viscosity and moisture content as presently claimed.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use ethylene-methyl acrylate as the copolymer in JP 54129050 in order to produce masterbatch that imparts good light shielding and appearance to polyester composition, and thereby arrive at the claimed invention.

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10. Claims 4-5, 7, 9, 14-15, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP 370424.

The disclosure with respect to EP 370424 in paragraph 6 above is incorporated here by reference.

The difference between EP 370424 and the present claimed invention is the requirement in the claims of the amount of the masterbatch or concentrate in the polyester composition.

There is no explicit disclosure in EP 370424 of the amount of masterbatch present in the polyester composition.

However, col.2, lines 36-39 of EP 37424 discloses adding masterbatch to base resin, i.e. polyester, in order to prevent light shielding trouble and appearance trouble such as irregular color and weld lines. In light of this disclosure, it would have been within the skill level of one of ordinary skill in the art to choose amount of masterbatch necessary to prevent light shielding and appearance troubles in polyester composition.

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to choose amount of masterbatch or concentrate utilized in the polyester composition, including that presently claimed, in order to prevent light shielding trouble and appearance trouble, and thereby arrive at the claimed invention.

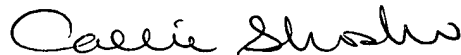
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho  
Primary Examiner  
Art Unit 1714

CS  
5/20/05